

It is respectfully submitted that this rejection is improper in view of the distinction between 35 U.S.C. §132 and 35 U.S.C. §112, first paragraph. Specifically, 35 U.S.C. §132 prohibits introduction of new matter into the disclosure of an application, and 35 U.S.C. §112, first paragraph requires that claim language be supported in the specification. In re Rasmussen, 211 USPQ 323, 326 (CCPA 1981). As stated with regard to the reissue application of Rasmussen:

Broadening a claim does not add new matter to the disclosure.... The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore is §112, first paragraph, not §132. The latter section prohibits addition of new matter to the original disclosure. It is properly employed as a basis for objection to amendments to the abstract, specifications, or drawings attempting to add new disclosure to that originally presented.

Id. (Attached hereto for the Examiner's convenience is a copy of the Rasmussen case).

Hence, it is respectfully requested that the rejection of claims 21-42 under 35 U.S.C. §112, first paragraph for the addition of new matter be withdrawn.

II. Enablement

Claims 21-42 were rejected under 35 U.S.C. §112, first paragraph, as "containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for reasons of record".

In past Papers, Applicants and the Examiner have exchanged views regarding certain passages in the specification relating to disclosure about high levels of background signal generated by certain primer-based amplification and detection methods. As noted by the Examiner, the Applicants have taught that one method for preventing high levels of background signal is to utilize a signal primer that may not function as amplification primer (column 6, lines 28-37). This characteristic of the signal primer has been added to claims 21 and 29.

Thus, it is respectfully submitted that the claims meet the requirements of 35 U.S.C. §112, first paragraph.

III. Conclusions

The claims of the present application are believed to be in condition for allowance, and early notice thereof is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made".

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David W. Highet', with a stylized flourish at the end.

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VERSIONS WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Please amend claims 21 and 29 as follows:

21. (twice amended) A method for concurrently generating a secondary amplification product and an amplification product in a primer based nucleic acid amplification reaction, the method comprising:

a) hybridizing a signal primer to a target sequence and hybridizing a first amplification primer to the target sequence upstream of the signal primer wherein a characteristic of said signal primer is that it may not function as an amplification primer;

b) extending the hybridized signal primer on the target sequence to produce a signal primer extension product and extending the hybridized first amplification primer on the target sequence such that extension of the first amplification primer displaces the signal primer extension product from the target sequence;

c) hybridizing a second amplification primer to the signal primer extension product and extending the hybridized second amplification primer on the signal primer extension product to produce a second amplification primer extension product comprising a newly synthesized strand;

d) displacing the newly synthesized strand from the signal primer extension product; and

e) hybridizing the signal primer to the displaced newly synthesized strand and extending the signal primer such that a double stranded secondary amplification product is generated.

29. (twice amended) A method for concurrently generating a secondary amplification product and an amplification product in a primer based nucleic acid amplification reaction, the method comprising:

a) hybridizing a first signal primer to a first strand of a double-stranded target sequence and hybridizing a first amplification primer to the first strand of the target sequence upstream of the first signal primer wherein a characteristic of said signal primer is that it may not function as an amplification primer;

b) extending the hybridized first signal primer on the first strand to produce a first extension product and extending the hybridized first amplification primer on the first strand such that extension of the first amplification primer displaces the first extension product from the target sequence;

c) hybridizing a second signal primer to the first extension product and hybridizing a second amplification primer to the first extension product upstream of the second signal primer;

d) extending the hybridized second signal primer on the first extension product to produce a second extension product and extending the hybridized second amplification primer on the first extension product such that extension of the second amplification primer displaces the second extension product from the first extension product; and

e) hybridizing the first signal primer to the displaced second extension product and extending the hybridized first signal primer on the second extension product such that a double stranded secondary amplification product is generated.

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utile per inutile non-vitaltur might appropriately be applied here.

Court where the verbiage of synergism is used.¹ The maxim utile per inutile non vitiatur might appropriately be applied here.

Moreover, I should have been content to continue the present ambiguous stance with respect to synergism described in note 17 of the majority opinion, rather than to stand up and be counted in the current synergism controversy.²

Perhaps the word synergism should be discarded (except for its original meaning with respect to the interaction of chemicals or drugs, and for its use as a fashionable fad in television commercials, and for its theological and scriptural overtones).³ But abandoning the verbal trappings and "rhetoric of synergism" must not cause courts to overlook the importance of the requirement of novelty and invention, long required by the patent statutes and the Constitution.

As pointed out in *John Deere* itself, Congress may not "enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of * * * useful Arts.' This is the *standard* expressed in the Constitution and it may not be ignored." 383 U.S. at 6, 148 USPQ at 462.

Similarly, this Court has said: "Thus, the courts, in determining obviousness in a combination patent, must undertake the tripartite Graham inquiry without losing sight of the necessity to determine whether the device performs its function in an innovative fashion." 608 F.2d at 91, 203 USPQ at 965-966.

It must never be forgotten that the power given to Congress by Art. I, sec. 8, cl. 8 of the Constitution is "*To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.*" [Italics supplied] The primary policy of the patent laws is to promote invention for the benefit of the public. The private gain enjoyed by the patentee is secondary; the "exclusive Right"

conferred by the patent monopoly is merely the means of accomplishing the intended result of advancing the growth of science by adding to the sum of human knowledge. A patent cannot be sustained which would withdraw or subtract from what is already known and practiced. *Borden Co. v. Clearfield Cheese Co.*, 244 F.Supp. 366, 368, 146 USPQ 660, 661 (W.D. Pa. 1965). To fence in by a newly created monopoly elements previously available to the public (by aggregating them in a combination patent without any inventive innovation) would be contrary to public policy and fundamental principles of patent law.

To emphasize the importance of these constitutional aspects of our patent system, whether or not they are clothed in "the rhetoric of synergism," it seemed proper to dwell upon them specifically in this concurring opinion when joining in the judgment of the Court.

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Court of Customs and Patent Appeals

In re Rasmussen

No. 81-516

Decided June 4, 1981

PATENTS

1. Amendments to patent application — New matter (§13.5)

Claims — Specification must support (§20.85)

35 U.S.C. 132 prohibits introduction of new matter into disclosure of application; 35 U.S.C. 112, first paragraph, requires that claim language be supported in specification.

2. Amendments to patent application — New matter (§13.5)

Claims — Broad or narrow — In general (§20.201)

Specification — Claims as disclosure (§62.3)

Broadening claim does not add new matter to disclosure; disclosure is that which is taught, not that which is claimed; original claim is part of disclosure at time of

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filing; consideration of original claim as evidencing support in disclosure for later submitted claims does not warrant employment of 35 U.S.C. 132 as basis for rejection of later submitted claims on ground that latter are adding new matter to original claim portion of disclosure; to do so would render Section 132 redundant in light of Section 112, first paragraph; applicant is entitled to claims as broad as prior art and his disclosure will allow.

3. Amendments to patent application — New matter (§13.5)

Claims — Specification must support (§20.85)

Pleading and practice in Patent Office — Rejections (§54.7)

Proper basis for rejection of claim amended to recite elements thought to be without support in original disclosure is 35 U.S.C. 112, first paragraph, not Section 132; latter section prohibits addition of new matter to original disclosure; it is properly employed as basis for objection to amendments to abstract, specifications, or drawings attempting to add new disclosures to that originally presented; past opinions of Court of Customs and Patent Appeals, in cases in which Section 132 claim rejection was reviewed on Section 112 analysis, should not in future be viewed as having approved employment of Section 132 as basis for claim rejection; amended claims involved in those cases should have been rejected under Section 112, first paragraph; claim rejections in those cases could then have been explicitly affirmed or reversed on direct applications of Section 112, rather than on Section 112 analyses applied to Section 132 rejections; similarly, rejections of claims for lack of support when required in reissue applications should be made under Section 112, first paragraph, rather than under new matter prohibition of 35 U.S.C. 251; accordingly, such cases are overruled insofar as they approved rejection of claims under Section 132.

4. Claims — Broad or narrow — In general (§20.201)

Reissue — In general (§58.1)

Fact that claim may be broader than specific embodiment disclosed in specification is in itself of no moment; statutory provision for broadened claims in reissue applications is intended to meet precisely situation in which patentee has claimed less than he had right to claim.

5. Pleading and practice in Patent Office — In general (§54.1)

Specification — Sufficiency of disclosure (§62.7)

35 U.S.C. 112 requires disclosure of only one mode of practicing invention; insistence upon boilerplate recitation in specification that specific embodiment shown was not meant to limit breadth of claims, or that example given was only one of several methods that could be employed, is exaltation of form over substance.

Appeal from Patent and Trademark Office Board of Appeals.

Application for reissue of patent of Max Otto Henri Rasmussen, Serial No. 884,775, filed Mar. 8, 1978, for reissue of Patent No. 3,963,549, issued June 15, 1976. From decision affirming rejection of claim 6, applicant appeals. Reversed; Nies, J., dissenting.

George Vande Sande, Washington, D.C., for appellant.

Joseph F. Nakamura (Robert D. Edmonds, of counsel) for Patent and Trademark Office.

Before Markey, Chief Judge, and Rich, Baldwin, Miller, and Nies, Associate Judges.

Markey, Chief Judge.

The decision of the Patent and Trademark Office Board of Appeals (board) affirming the rejection of claim 6 under 35 USC 132 is reversed.

Background

Appealed claim 6 is contained in reissue application S.N. 884,775 filed March 8, 1978.¹ Original claim 6 in the reissue application was directed to a method of manufacturing a thermal insulating member.² Rasmussen described in his specification the steps of applying adhesive to one side of a tubular plastic film, winding the film around two spaced drums, and, when the desired number of layers have been wound, cutting the film layers

¹ That application seeks reissue of U.S. Patent 3,963,549, issued June 15, 1976.

² 6. A method of manufacturing a thermal insulating member from a thin film of plastic material and comprising a pair of spaced opposing generally parallel sidewalls which are bridged by a plurality of spaced transverse walls comprising the steps of:

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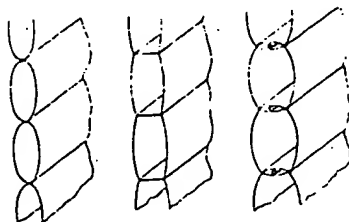
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transversely to the direction of winding. When the film units are unfolded and extended, a plastic laminate in one of the forms shown below results:



Viewing the particular method of adhering the layers of tubular film as immaterial, Rasmussen later amended claim 6, *inter alia*, by substituting "adheringly applying" for language specifying use of adhesives.³

winding a continuous length of a tube formed of the plastic material in its flattened state into a generally cylindrical member whose circumference corresponds to the desired width of the insulating member,

applying to the flattened tube a band of adhesive of predetermined width corresponding substantially to the width of said spaced transverse walls and thus to the desired spacing between the sidewalls, said application of adhesive occurring prior to the contacting of the flattened tube during the winding step to the portion of the tube already wound onto the cylindrical member so that successive layers of said tubular member on said cylindrical member adhere to each other along the predetermined width of adhesive application,

terminating the winding of the plastic tube onto the cylindrical member when a predetermined number of layers of the plastic tube has been wound thereon corresponding to the desired length of the thermal insulating member,

and cutting the superimposed assemblage of successively adhering layers of the plastic tube in a direction transverse to the longitudinal direction of the tube,

said assemblage when longitudinally straightened and then extended in a direction transverse to the longitudinal direction of the tube so as to expand the successively joined tubes forming said thermal insulating member. [Emphasis added.]

³ Amended claim 6 reads as follows:

6. A method of manufacturing a thermal insulating member from a thin film of material and comprising a pair of spaced opposing generally parallel sidewalls which are bridged by a plurality of spaced transverse walls comprising the steps of:

winding a continuous length of a tube formed of the material in its flattened state onto a generally cylindrical member whose circumference corresponds to the desired width of the insulating member, each successive layer of

The examiner rejected the amended claim, saying "adheringly applying" was "new matter" prohibited by §132, explaining that limitation of the scope of the original disclosure to use of adhesives meant that allowance of the broader claim would be an enlargement of the scope of the disclosure.

The board affirmed, saying Rasmussen's application disclosed only one embodiment (applying adhesive to join the sheets) and that broadening the scope of the claim added new matter to the application.

Issue

The issue presented is whether amended claim 6 was properly rejected under 35 USC 132.

Opinion

[1] Confusion is generated when related but distinct statutory provisions are treated as interchangeable. Section 132 prohibits the introduction of new matter into the disclosure of an application. Section 112, first paragraph, requires that claim language be supported in the specification. This court, having said that a rejection of an amended claim under §132 is equivalent to a rejection under §112, first paragraph, for lack of support, appears to have contributed to the treatment of those separate statutory sections as interchangeable. See *In re Hogan*, 559 F.2d 595, 608, 194 USPQ 527, 539 (CC-

said tube being wound to overlie the immediately preceding layer to provide thereby a generally cylindrical band of tubular layers extending axially along said cylindrical member a distance corresponding substantially to the flattened width of said tube,

adheringly applying the flattened tube during the winding step to the portion of the tube already wound onto the cylindrical member over a band of predetermined width corresponding substantially to the desired width of said spaced transverse walls and thus to the desired spacing between said sidewalls,

terminating the winding of the tube onto the cylindrical member when a predetermined number of layers of the tube has been wound thereon corresponding to the desired length of the thermal insulating member,

and cutting the superimposed assemblage of successively adhering layers of the tube in a direction transverse to the longitudinal direction of the tube,

said assemblage when longitudinally straightened and then extended in a direction transverse to the longitudinal direction of the tube so as to expand the successively joined tubes forming said thermal insulating member. [Emphasis added.]

PA 1977), *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 99 (CCPA 1976), *In re Bowen*, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974), *In re Smyth*, 480 F.2d 1376, 1385, 178 USPQ 279, 286 (CCPA 1973).⁴

Apparently reluctant to reverse on the sole ground that an improper statutory provision had been employed, and recognizing the burden on the parties inherent in a return of the case for application of §112, this court has reviewed §132 claim rejections on the basis of whether the rejected claim found support in the original disclosure. See *In re Eickmeyer*, 602 F.2d 974, 981, 202 USPQ 655, 662 (CCPA 1979); *In re Barker*, 559 F.2d 588, 593-94, 194 USPQ 470, 474 (CCPA 1977); *In re Winkhous*, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975).

Similarly, new matter rejections of claims under §251 have been reviewed on the basis of a §112 analysis, that is, on whether a claim found support in an original patent. See *In re East*, 495 F.2d 1361, 1366, 181 USPQ 716, 719 (CCPA 1974).

As is illustrated in the present case, employment of §§132 and 112 as interchangeable leads to confusion of two distinct concepts: (1) the adding of new matter to the disclosure; and (2) the broadening of a claim.

[2] Broadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed.⁵ An applicant is entitled to claims as broad as the prior art and his disclosure will allow.

[3] The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore, is §112, first paragraph, not §132. The latter section prohibits addition of new matter to the original disclosure. It is properly employed as a basis for objec-

tion to amendments to the abstract, specifications, or drawings attempting to add new disclosure to that originally presented. Past opinions of this court, in cases in which a §132 claim rejection was reviewed on a §112 analysis, should not in future be viewed as having approved the employment of §132 as a basis for claim rejection. The amended claims involved in those cases should have been rejected under §112, first paragraph. The claim rejections in those cases could then have been explicitly affirmed or reversed on direct applications of §112, rather than on §112 analyses applied to §132 rejections.⁶ Accordingly, such cases are overruled insofar as they approved rejection of claims under §132.

Turning to the merits of this appeal, we will again treat a §132 claim rejection before us as though it had been made under §112, first paragraph. We proceed to decide the case on that basis in the interest of judicial economy. Were we to merely reverse the rejection as having been made under an inappropriate statutory provision, and say no more, the PTO would presumably enter a rejection under §112 and that decision would then be appealable to this court.

Amended claim 6 recites the adhering step as "adheringly applying" one layer of tube to an adjacent earlier layer. Rasmussen's specification describes that step as follows: "[A]dhesive is applied to the tubular foil 4 in a narrow or broader strip, possibly in two narrow strips. Accordingly, the face of the tubular foil successively sticks to the winding lying on the drums." The language of the specification thus describes one method of "adheringly applying" one layer to the other.

[4] As above indicated, that a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment. Indeed, the statutory provision for broadened claims in reissue applications is intended to meet precisely the situation in which a patentee has claimed "less" than he had a right to claim. 35 USC 251.

In *In re Smyth*, 480 F.2d 1376, 1384, 178 USPQ 279, 285 (CCPA 1973), this court stated:

A hypothetical situation may make our point clear. If the original specification of

⁴ MPEP 706.03(o), 608.04-608.04(c), and 1411.02 relate to considerations set forth herein.

⁵ We deal here with rejection of amended claims, and, by implication, with rejection of entire new claims submitted after filing. An original claim is part of the disclosure at the time of filing. *In re Anderson*, 471 F.2d 1237, 1238, 176 USPQ 331, 332 (CCPA 1973). Consideration of an original claim as evidencing support in the disclosure for later submitted claims does not warrant employment of §132 as a basis for rejection of later submitted claims on the ground that the latter are adding new matter to the original claim portion of the disclosure. To so hold would render §132 redundant in light of §112, first paragraph.

⁶ Similarly, rejections of claims for lack of support when required in reissue applications should be made under §112, first paragraph, rather than under the new matter prohibition of 35 USC 251.

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appeal, we ction before under §112, decide the t of judicial verse the re- der an inap- and say no bly enter a at decision is court.

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a patent application on the scales of justice disclosed only a 1-pound "lead weight" as a counterbalance to determine the weight of a pound of flesh, we do not believe the applicant should be prevented, by the so-called "description requirement" of the first paragraph of §112, or the prohibition against new matter of §132, from later claiming the counterbalance as a "metal weight" or simply as a 1-pound "weight" although both "metal weight" and "weight" would indeed be progressively broader than "lead weight," including even such an undisclosed, but obviously art-recognized equivalent, "weight" as a pound of feathers. The broader claim language would be permitted because the *description of the use and function* of the lead weight as a scale counterbalance in the *whole disclosure* would immediately convey to any person skilled in the scale art the knowledge that the applicant invented a scale with a 1-pound counterbalance weight, regardless of its composition.

[5] Similarly, one skilled in the art who read Rasmussen's specification would understand that it is unimportant *how* the layers are adhered, so long as they are adhered.⁷ Thus the phrase "adheringly applying" is supported by the example found in the specification.

Conclusion

The phrase "adheringly applying" being supported in the specification, rejection of that claim under 35 USC 132, first paragraph, is *reversed*. Rejection under the appropriate statutory provision, 35 USC 112, would have been inappropriate.

Reversed

The board seemed to realize that 35 USC 112 requires disclosure of only one mode of practicing the invention, but nevertheless insisted upon a boilerplate recitation in the specification that the specific embodiment shown was not meant to limit the breadth of the claims, or that the example given was only one of several methods which could be employed. Such insistence is here an exaltation of form over substance.

District Court, S.D. New York

Hedaya Brothers, Inc.
v. Capital Plastics, Inc.

No. 79 Civ. 4104

Decided July 23, 1980

COPYRIGHTS

1. Infringement — Tests of (§24.209)

Test for determining whether copyright infringement has occurred is whether average lay observer would find substantial similarity in designs, recognizing copy as appropriation of copyrighted work; plaintiff in copyright infringement action can only prevail if overall aesthetic impressions created by designs are substantially same.

2. Infringement — In general (§24.201)

Matter copyrightable — In general (§24.301)

In making determination of copyright infringement, it must be remembered that plaintiff's copyright does not protect idea of design, but only plaintiff's particular expression of that idea; even if defendant has sedulously borrowed each of plaintiff's ideas, that alone is not violative of copyright statute.

3. Infringement — In general (§24.201)

That ideas contained in design were old hat and originality of design was minimal must also be weighed in considering claim of infringement because, where basic design is not original with plaintiff small variations by subsequent designers may protect them from charges of infringement.

4. Infringement — Tests of (§24.209)

Accused has not infringed plaintiff's copyrights where aesthetic appeals of parties' respective designs are not substantially same, and would not strike average lay observer as being substantially same.

5. In general (§24.01)

Notice of copyright (§24.35)

Copyright infringement action is governed by Copyright Act of 1909 where designs in question were created and published prior to January 1, 1978, effective date of Copyright Act of 1976; under old Act, statutory protection was obtained only by publication of work with notice of copyright required by what was formerly 17 U.S.C. 10, in form required by former 17 U.S.C. 19; while under saving provision of former 17